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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,483	08/23/2001	Ronald John Shimek	12929.1033USRE	9000

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EXAMINER

PRICE, CARL D

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/935,483	Applicant(s) SHIMEK ET AL.	
	Examiner CARL D. PRICE	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08-23-2001 (preliminary amendment) .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 41-51 and 53-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-40 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

Reissue Application

Summary of Claims

Original patented claims 1-18 are presented as unchanged.

New claims 19-55 have been presented for examination in the preliminary amendment filed on 08-23-2001.

Claims 41-51 and 53-55 are however withdrawn from consideration as being directed to a non-elected invention. See the reasons for this restriction requirement set forth herein below.

Restriction Requirement

Newly submitted claims 41-51 and 53-55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-40 and 52, drawn to methods of making a universal gas combustion chamber and a universal combustion chamber, classified in class 126, subclass 512.

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- II. Claims 41-51 and 53-55, drawn to a bottom panel for use in a plurality of different types of fireplaces, a gas burner for a fireplace, a method of making a bottom panel for a fireplace, and a method of making a burner for a fireplace, classified in class 431, subclasses 125.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination. In particular, the combinations as recited in independent claims 1,8,14,19,29,32 and 52, respectively do not require the “bottom portion” recited in the subcombination claims 41, 46, 53 and 55, respectively.

Claims 41-51 and 53-55: Withdrawn from consideration

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 41-51 and 53-55 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Applicant's continuing obligation under 37 CFR 1.178(b)

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,941,237 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Offer to Surrender

The original patent, or statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

Reissue Oath/Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

1) Applicants have not given a **post office/mailing address** anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or

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declaration. A statement over applicant's signature providing a complete post office address is required. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

2) The Declaration made by each of the applicants does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office "all" information known to the person to be material to patentability as defined in 37 CFR 1.56.

3) The citizenship, mailing address and residence of "each" inventor must be provided in the declaration under 37 CFR 1.63.

4) The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. Applicant does not state the "belief that the original patent is wholly or partly inoperative or invalid".

5) The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR

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1.175(a)(1) and MPEP § 1414. Specific changes or amendments to the claims must be identified. Applicant only generally references “confusing” language appearing in “some of the existing claims” and “New claims are included in this application to correct this deficiency in the existing claims.”. When new claims are presented, their differences from the original claims must be pointed out. Additionally, while applicant states the claims are confusing, no amendments have been made to the claims in the original patent to correct this deficiency.

6) The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Claims rejected - defective reissue declaration

Claims 1-40 and 52 and rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2,4,19,20,24-26,28-33,35-37,40 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14, 16 and 17 of U.S. Patent No. 5,996,575. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the scope of the more broadly recited invention set forth in claims 1,2,4,19,20,24-26,28-33,35-37,40 and 52 of the present application would be encompassed within the scope of the more narrowly defined invention set forth in claims 1, 14, 16 and 17 of U.S. Patent No. 5,996,575.

Claims 1,19,29 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2,9,10 and 16 of U.S. Patent No. 6,170,481. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the scope of the more broadly recited invention set forth in claims 1, 2,9,10 and 16 of the present application would be encompassed within the scope of the more narrowly defined invention set forth in claims 1, 2,9,10 and 16 of U.S. Patent No. 6,170,481.

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Claims 1,8,9,19,20,26 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 5,647,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the scope of the more broadly recited invention set forth in claims 1,8,9,19,20,26 and 52 of the present application would be encompassed within the scope of the more narrowly defined invention set forth in claims 7-10 of U.S. Patent No. 5,647,340.

Improper recapture

Claims 19-40 and 52 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue that was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 20-40 and 52 do not include the following limitations added by amendment to the claims during the prosecution of the original application.

Claims 20-28 do not include:

- 1) “universal open box”,
- 2) “two side panels”,
- 3) “dried after molding”,
- 4) “impact resistant box of panels of a fireplace”,
- 5) “glass door means attached to said panels”,
- 6) “a gas tight closed box fireplace”.
- 7) “burner means supported by said floor panels”,

Claims 29-31 do not include:

- 1) “universal open box”.
- 2) “two side panels”,
- 3) “impact resistant box of panels of a fireplace”,
- 4) “burner means supported by said floor panels”,
- 5) “glass door means attached to said panels”,
- 6) “gas tight closed box fireplace”.

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Claims 32-40 do not include:

- 1) “two side panels”,
- 2) “universal open box”,
- 3) “burner means supported by said floor panels”,
- 4) “glass door means attached to said panels”.

Claim 52 does not include:

- 1) “inorganic binder”,
- 2) “fireplace combustion chamber having an open side for supporting door means
and”,
- 3) “an uncured stiff one piece”,
- 4) “a rigid combustion chamber ready for assembly of said door means and gas
burner to form a unique fireplace”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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d Claims 20,21,29,30,32,37,40 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamb et al. ¹³⁶³

Lamb et al show and disclose an a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30), combustion chamber The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 – 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimek et al (U.S. Patent No. 4,793,322) in view of Lamb et al (UK 2 257 783), Rex, Jr. et al (U.S. Patent No. 3,100,734) or Champion.

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Shimek et al show and disclose a refractory panel open box combustion chamber (figure 2) having sidewalls (24,25) and a refractory material bottom panel (80) and rear wall (26). A burner (62) is positioned on and through an opening in the refractory material bottom panel and relative thereto to provide a flame within the chamber. A front panel (at 81) coupled to the firebox. The bottom portion (45,48,75) provides fluid communication of combustible gas to the aperture.

Lamb et al show and disclose an a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30). The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.

Lamb et al show and disclose an a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30). The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a

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bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.

Champion shows (figure 1) a one-piece open box refractory material combustion chamber (15) having sidewalls (33,34) and a bottom (30) rear wall (31) and top wall (32). The bottom wall of the combustion chamber of Champion supports a wood log type burner

Rex, Jr. et al show and disclose a combustion chamber (figure 1) having sidewalls and a bottom (not referenced). The “self supporting”, rigid or stiff, combustion chamber (see column 2, lines 40-41) of Rex, Jr. et al being made by the method of 1) vacuum molding ceramic fiber, mixed with an aqueous solution water and an “inorganic” binder (see column 2, lines 7-8; “These fibers are placed in a tank of water with colloidal silica), 2) removing the molded chamber from the mold followed by 3) thorough drying. The combustion chamber is then heated in the furnace after installation to temperatures “up to 2300” degrees F.

In regard to claims 20 – 40 and 52, for the purpose of providing a suitable refractory, (e.g. – high temperature heat resistant material) for the combustion chamber, and to simplify assembly of the Shimek et al fireplace, it would have been obvious to a person having ordinary skill in the art to form the combustion chamber of Shimek et al as a one-piece molded member having top, rear, side and bottom walls of the same refractory material, in view of the teachings of Lamb et al, Champion and Rex, Jr. et al. Also, for the purpose of providing a suitable refractory material for the Shimek et al combustion chamber, it would have been obvious to a

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person having ordinary skill in the art to make the one-piece chamber by the method of 1) molding an aqueous slurry of ceramic fiber and an inorganic binder removing the molded chamber from the mold followed by drying in view of the teachings of Lamb et al or Rex, Jr. et al. In regard to claims 22,23,34 and 35, Official Notice is taken that it is well known to use open pan burners as a flame source in simulated log type gas fireplaces. Thus, in view of that which is well known, it would have been obvious to a person having ordinary skill in the art to modify the burner of Shimek et al to be in the form of an open pan type burner.

Conclusion

See the attached USPT FORM 948 for prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPTO CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is 703-308-1953. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1148/0858.

A handwritten signature in black ink, appearing to read 'Carl D. Price', with a stylized, flowing script.

CARL D. PRICE
Primary Examiner
Art Unit 3743

cp
December 9, 2002